

Doc Code: AP.PRE.REQ



PTO/SB/33 (01-09)

Approved for use through 02/28/2009. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

040520

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed  
name \_\_\_\_\_

Application Number

10/509,673

Filed

10/08/2004

First Named Inventor

Katsuyoshi Nagao

Art Unit

3761

Examiner

Philip R. Wiest

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 42,573

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

Daniel A. Geselowitz, Ph.D.

Typed or printed name

(202) 659-2930

Telephone number

February 23, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



U.S. Patent Application Serial No. 10/509,673  
Remarks filed February 23, 2009  
Reply to OA dated October 23, 2008

**REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**

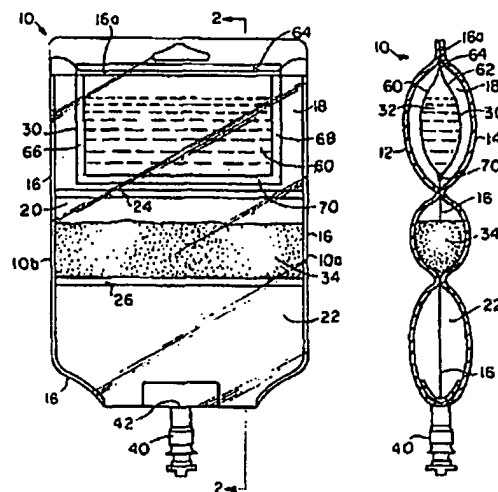
Claims 1, 3 and 5-25 are pending in this application. Applicant submits that the following arguments are succinct and concise and point out clear errors in the stated *prima facie* cases of obviousness.

Claims 1, 3, 5, 6, 9-12, 14-20, and 22-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Barney (US 5,462,526) in view of Larkin (US 4,602,910). (Office action paragraph no. 2)

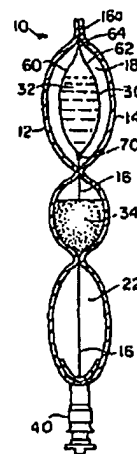
Claims 7 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Barney in view of Larkin, and further in view of Inoue (US 5,423,421). (Office action paragraph no. 7)

Claims 13 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Barney in view of Larkin, and further in view of Becker (US 6,319,243). (Office action paragraph no. 8)

(i) Barney discloses a peelable seal 24 and a small container 60 as shown in Figs. 1 and 2 (reproduced below). The small container 60 is sealed with a peelable seal 70 in such a manner that it opens in response to external force. When an external force is applied, the peelable seal 70 of the small container 60 is opened first and then the peelable seal 24 is peeled.

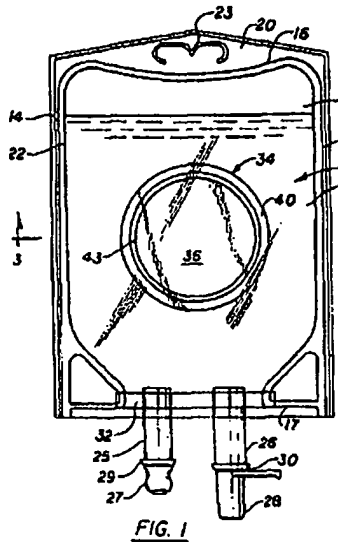


*Fig. 1*

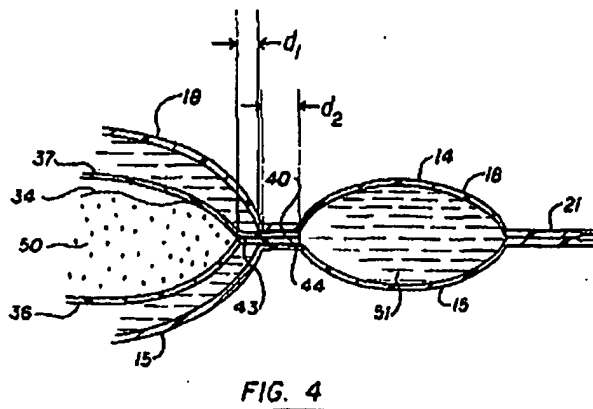


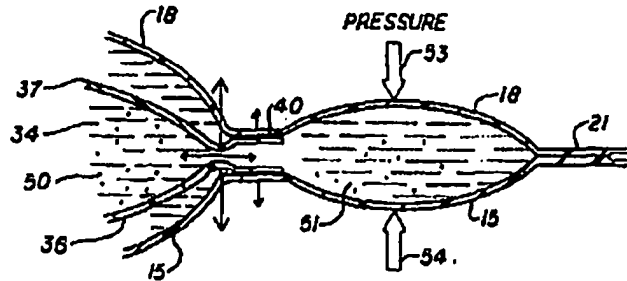
*Fig. 2*

(ii) Larkin merely discloses a medical container having a large chamber 10 surrounding a small medical container 36. The medical container of Larkin does not have a partition member. (See Fig. 1, reproduced below).



The small medical container 36 is openably sealed with a seal 43. The outer surfaces of the small container are bonded to the inner surfaces 15, 18 of the container. The seal 43 is weaker than the seal 40 between the small medical container 36 and the large chamber 10. In such a configuration, the seal 43 of the small medical container 36 is opened by the application of pressure. (See Figs. 4 and 5, reproduced below).

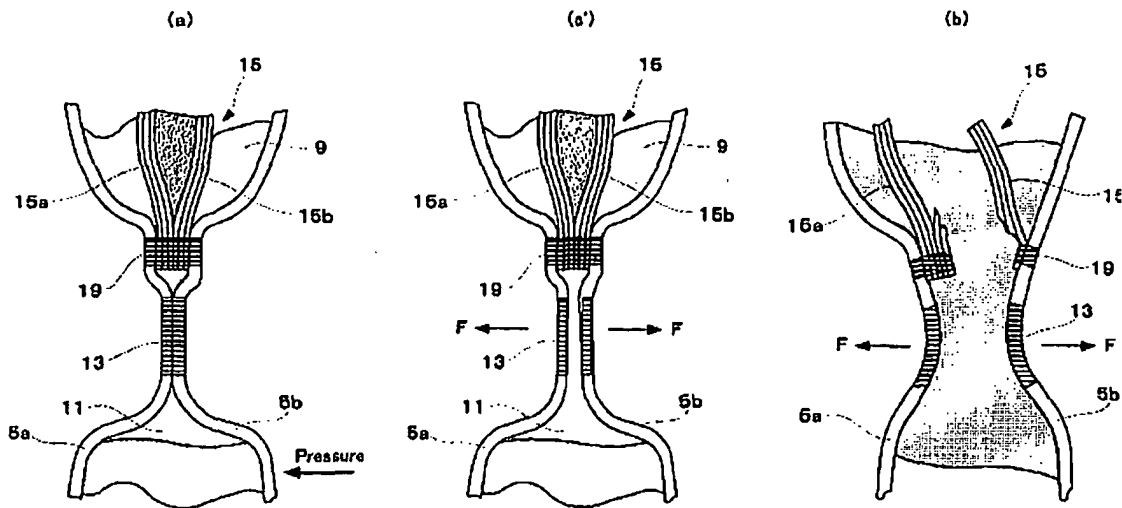




**FIG. 5**

(iv) The Examiner asserts that the present invention would have been easily achieved by combining the above-described features of Barney and Larkin.

However, the main feature of the present invention is that a small chamber is opened by the use of the force that separates the partition seal. In order to make the mechanism easier to understand, Applicant here reproduces Figs. 2(a) and (b), and has added explanatory figure (a') below, which shows the intermediate condition of Fig. 2 in the present Specification.

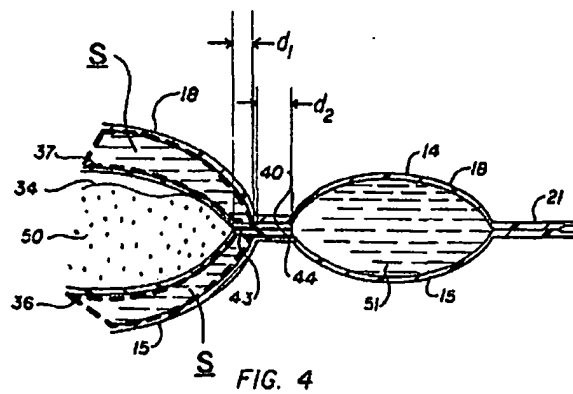
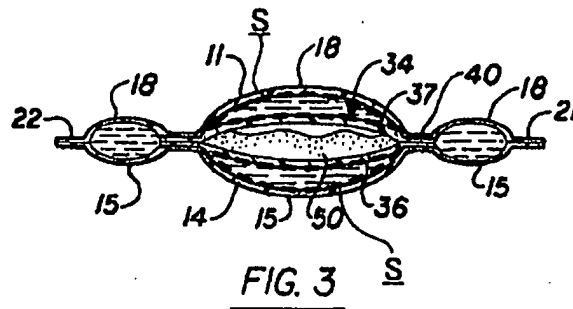


As illustrated in figure (a'), when pressure is applied to the main body of the container, the partition seal opens first. The opening of the partition seal causes the small container (b) to open due to the separating force of the inner surfaces of the container.

(v) In contrast, Barney teaches that the small container and the partition seal open separately, and nowhere teaches that the small container and the partition seal open at the same time (see column 8, lines 2 to 10). Furthermore, Barney is silent about such an object.

Larkin merely discloses a large chamber 10 surrounding a small medical container and is silent about the partition seal. Larkin only teaches that the small medical container can be opened by the application of external force to the large chamber.

In addition, the Examiner has interpreted Figs. 3 and 4 of Larkin (reproduced below), as showing that "regions S" formed between the secondary container and front and back walls 15 and 18 of the primary container store a medicament. However, regions S do not store a medicament and are left empty, as described under the heading of "Fabrication" in column 3 of Larkin. Therefore, sealed area 40 serves not as a partitioning seal portion separating chambers storing medicaments but merely as a means for fixing the secondary container to the primary container.



U.S. Patent Application Serial No. 10/509,673  
Remarks filed February 23, 2009  
Reply to OA dated October 23, 2008


(vi) Accordingly, neither Barney nor Larkin teaches the relationship between the partition seal and the small container. In other words, neither Barney nor Larkin discloses the feature of the present invention, i.e., the small container is opened by utilizing the opening the partition seal.

In conclusion, the present invention is not obvious over Barney in view of Larkin. The citations of Inoue and Becker do not correct the deficiency in Barney and Larkin.

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

KRATZ, QUINTOS & HANSON, LLP

  
Daniel A. Geselowitz, Ph.D.  
Agent for Applicants  
Reg. No. 42,573

DAG/xl

Atty. Docket No. 040520  
Suite 400  
1420 K Street, N.W.  
Washington, D.C. 20005  
(202) 659-2930



23850

PATENT & TRADEMARK OFFICE

Enclosures: Petition for Extension of Time  
Notice of Appeal  
Pre-Appeal Brief Request for Review Form SB/33

H:\040\040520\Remarks for Pre-Appeal Brief Request